

3106



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of THOMAS J. PALENCHAR et al.

Serial No.: 08/698,853

Art Unit: 3106

Dated: August 16, 1996

Examiner: B. Avery

For: VEHICLE AIR INTAKE & METHOD

Docket No.: 13-611

*M. [Signature]*  
6-17-97  
GROUP 310  
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Watts, Hoffmann, Fisher & Heinke Co., L.P.A.  
P.O. Box 99839  
Cleveland, OH 44199-0839  
Telephone (216) 241-6700

Assistant Commissioner for Patents  
Washington, D.C. 20231

RESPONSE

Dear Sir:

Responsive to the communication of April 29, 1997, Applicant elects the Claims of Group I with traverse. It is respectfully submitted that the restriction requirement is improper.

In numbered Paragraph 1, on page 2 of the Action of April 29, it is stated that restriction between process and product is appropriate where "the process — can be practiced with another materially different product" or "the product as claimed can be used in a materially different process." The Examiner then states that in this case "the process can be used in a materially different product", suggesting as an example a humidifier. Given that what we are dealing with is a dehumidifier, we find difficulty in recognizing efficacy in the Examiner's statement.

Moreover, we respectfully submit the clear language of the claims makes it dispositively clear -- the process is to separating water from air supplied to a vehicle engine. While the Examiner may say that that limitation is in the preamble and not to be considered, the Examiner must also recognize that there is much authority for the concept that the preamble is indeed a portion of a claim which must be considered in interpreting its scope. Indeed, as recently as April 21, 1997 the Court of Appeals for

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by: *Eileen [Signature]*

the Federal Circuit has so held. See *Rowe v. Dror* \_\_\_ F3d \_\_\_; 42 USPQ 1550, 1553 (Fed. Cir. 1997). The *Rowe* case cites MPEP §608.01(m) as in accord.

Clause (a) of Claim 23 calls for passing air through the inlets of a grating positioned in the side of an engine hood. Given that the preamble has made it clear, we are talking of a vehicle engine, and it is clear that the hood is a vehicle hood, we fail to see how this step could find a counterpart in "an air cleaning device like a humidifier". Since such devices do not have engine hoods, it becomes difficult to pass air through an opening in an engine hood.

Clause (b), subsection (i), calls for trapping surface water flowing along the hood. We wonder where such water is in a "air cleaning device like a humidifier".

Section (b)(ii) is a further dehumidifying step hardly finding a counterpart in a humidifier. The further step (c) is within a hood, again, it is clear this is a vehicle hood which we don't find in "an air cleaning device like a humidifier".

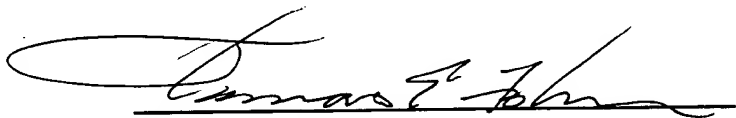
In sum, we contend the Examiner's analysis of Claim 23 fails to meet the standard she quotes for justifying a restriction requirement.

With respect to a line of demarcation between Groups I and II, recognize that requirements 1 and 2 set out in paragraph 2 on page 3 are expressed in the conjunctive. Thus, unlike the requirements 1 and 2 of paragraph 1, where meeting either requirement justifies restriction, here it must meet both tests 1 and 2. Given that the grating is an integral part of each of the claims of Group II, and given the particularity with which the grating is claimed in some of the combination claims, (consider Claim 23 and its dependents, for example), we wonder if the Examiner is telling us the grating is not part of the invention and is not required for patentability of the combination claims. Since the grating is included in all of the claims, and in some cases, with all of the particularity of the subcombination claims, we fail to see how it can be said that "the combination as claimed does not require the particulars of the subcombination as claimed for patentability".

A prompt action on the merits as to all of the claims is respectfully requested.

Respectfully submitted,

5/27/97  
Dated

  
Thomas E. Fisher  
Reg. No. 18,271